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EXAMINER

SALTARELLI, DOMINIC D

ART UNIT	PAPER NUMBER
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2421

MAIL DATE	DELIVERY MODE
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10/31/2012

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/631,583	Applicant(s) LIWERANT ET AL.	
	Examiner DOMINIC D. SALTARELLI	Art Unit 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 12 October 2012.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-12,36,37 and 40-50 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-12,36,37 and 40-50 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on October 12, 2012 has been entered.

Response to Arguments

2. Applicant's arguments with respect to the claims have been considered but are moot because the arguments do not apply to any of the references being used in the current rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2421

4. Claims 1-6, 36, 37, 40-44, and 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild (US 2001/0047294 A1, of record) in view of “Streaming Email” (XP-002150023, supplied by applicant), Sezan et al. (6,236,395, of record) [Sezan], and Kidder (5,898,833).

Regarding claim 1, Rothschild discloses a method of sending a video segment and an associated advertisement over a computer network (paragraph 48), comprising:

(a) acquiring a video segment from a sender at a computer system (the video portion of a video message which is the personal communication, paragraph 48);

(b) acquiring advertisements from advertisers at the computer system (third party, advertiser provided advertisements, paragraph 49);

(c) offering to the sender an opportunity to indicate a selection of an advertisement of the advertisements to be associated with the video segment (pull down menu 404, paragraph 51);

(d) accepting from the sender the indication of a selection of the advertisement to be associated with the video segment (the send message button which indicates the sender has selected the desired advertisement and is ready to send the message, paragraph 53).

Rothschild fails to disclose acquiring a still image in the form of a thumbnail and assuring that the video segment is in a streaming format; creating an identifier for the video segment, wherein the identifier includes the still image

Art Unit: 2421

and a link to the video; associating the video segment and the advertisement; embedding the video segment, identifier, and associated advertisement into a web page; and sending the web page with the embedded video segment, the identifier, and the associated advertisement over the computer network to a receiving computer system.

In an analogous art, "Streaming Email" teaches sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (pgs. 308-313, "Video Express Email"), providing the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format, as taught by "Streaming Email" for the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

Rothschild and "Streaming Email" fail to disclose acquiring a still image in the form of a thumbnail and the identifier created includes the still image and embedding the video segment, identifier, and associated advertisement into a web page.

In an analogous art, Sezan teaches generating and associating thumbnail images with a video file in order to assist users in selecting video content for viewing (col. 4 line 40 - col. 5 line 2).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild and "Streaming Email" to include associating a thumbnail image with the video file, as taught by Sezan, for the benefit of assisting users in selecting video content for viewing, as a thumbnail image provides a user with a brief hint or indicator as to the content of the video, and assists a viewer in deciding whether to view the entire file.

Rothschild, "Streaming Email", and Sezan fail to disclose and embedding the video segment, identifier, and associated advertisement into a web page.

In an analogous art, Kidder discloses it was well known in the art at the time to embed video content into web pages for delivery of video content to viewers (fig. 3).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild, "Streaming Email" and Sezan to include and embedding the video segment, identifier, and associated advertisement into a web page, as taught by Kidder. The pointer to a network location taught by "Streaming Email" could just as well be a URL to a web address with the embedded video content and associated information, a well known means for distributing video content that includes the benefit of a unified

Art Unit: 2421

interface for content delivery by a service provider who may wish to display additional advertising or user options via a web page layout.

Regarding claim 2, Rothschild, "Streaming Email", Sezan, and Kidder disclose the method of claim 1, wherein the step of offering to a sender an opportunity to indicate a selection of an advertisement of the advertisements includes a criterion selectable by the sender (via pull down menu 404, Rothschild, paragraph 51).

Regarding claim 3, Rothschild, "Streaming Email", Sezan, and Kidder disclose the method of claim 2, wherein said criterion is a remuneration paid for selected said advertisement (Rothschild, paragraph 49).

Regarding claims 4-6, Rothschild, "Streaming Email", Sezan, and Kidder disclose the method of claims 1 and 2, and further disclose the step of offering to a sender an opportunity to indicate a selection of an advertisement includes a randomized default selection if the sender fails to indicate a selection (Rothschild, paragraph 52, where if the sender fails to select a particular advertisement, they may select that a randomly selected advertisement be shown).

Art Unit: 2421

Regarding claim 36, Rothschild teaches a method for operating a video-sharing server on a network comprising:

storing a plurality of advertisements from advertisers (paragraph 64); and receiving from a client a video and a selection of one of the plurality of advertisements (paragraphs 48 and 57).

Rothschild fails to disclose receiving a still image in the form of a thumbnail confirming that the video is in streaming format, storing the video at a network accessible location, generating an identification tag including the still image and a link to the network accessible location, generating a web page containing the identification tag and the selected one of the plurality of advertisements and transmitting the web page containing the identification tag and the selected one of the plurality of advertisements over the computer network to a receiving computer system.

In an analogous art, "Streaming Email" teaches sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (pgs. 308-313, "Video Express Email"), providing the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include sending video email messages in streaming format by creating a pointer included in a text email

Art Unit: 2421

message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format, as taught by "Streaming Email" for the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

Rothschild and "Streaming Email" fail to disclose acquiring a still image in the form of a thumbnail and the identifier created includes the still image and generating a web page containing the identification tag and the selected one of the plurality of advertisements and transmitting the web page containing the identification tag and the selected one of the plurality of advertisements over the computer network to a receiving computer system.

In an analogous art, Sezan teaches generating and associating thumbnail images with a video file in order to assist users in selecting video content for viewing (col. 4 line 40 - col. 5 line 2).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild and "Streaming Email" to include associating a thumbnail image with the video file, as taught by Sezan, for the benefit of assisting users in selecting video content for viewing, as a thumbnail image provides a user with a brief hint or indicator as to the content of the video, and assists a viewer in deciding whether to view the entire file.

Rothschild, "Streaming Email", and Sezan fail to disclose and embedding the video segment, identifier, and associated advertisement into a web page.

In an analogous art, Kidder discloses it was well known in the art at the time to embed video content into web pages for delivery of video content to viewers (fig. 3).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild, "Streaming Email" and Sezan to include and embedding the video segment, identifier, and associated advertisement into a web page, as taught by Kidder. The pointer to a network location taught by "Streaming Email" could just as well be a URL to a web address with the embedded video content and associated information, a well known means for distributing video content that includes the benefit of a unified interface for content delivery by a service provider who may wish to display additional advertising or user options via a web page layout.

Regarding claim 37, Rothschild, "Streaming Email", Sezan, and Kidder disclose the method of claim 36, wherein receiving the video includes receiving an HTTP post (Rothschild teaches the email is assembled and transmitted via interactions with web site 110, paragraph 48).

Regarding claim 40, Rothschild, "Streaming Email", Sezan, and Kidder disclose the method of claim 36, wherein the link includes a path ("Streaming Email" teachings sending a pointer file which designates the location of the file

Art Unit: 2421

for streaming, page 308) or URL (Kidder, fig. 3, web pages are designated with URLs).

Regarding claims 41 and 47, Rothschild, "Streaming Email", Sezan, and Kidder disclose the method of claims 1 and 36, wherein acquiring a video segment and a still image in the form of a thumbnail from a sender at a computer system includes receiving the video segment through a Hypertext Transfer Protocol (HTTP) port (Rothschild, fig. 1, interactions take place through website 110).

Regarding claims 42 and 48, Rothschild, "Streaming Email", Sezan, and Kidder disclose the method of claims 1 and 36, but fail to disclose assuring that the video segment is in a streaming video format includes analyzing a file representing the video segment to determine if the file is compatible with streaming video.

Examiner takes official notice that analyzing a file representing a video segment to determine if the file is compatible with streaming video in applications involving the distribution of streaming video files is notoriously well known in the art, as a verification step conserves system resources to prevent unnecessary transcoding.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method of Rothschild, "Streaming Email", Sezan, and Kidder to

Art Unit: 2421

include analyzing a file representing the video segment to determine if the file is compatible with streaming video.

Regarding claims 43, 44, 49, and 50, Rothschild, "Streaming Email", Sezan, and Kidder disclose the method of claims 1 and 36, wherein sending the web page with the embedded video segment, identifier, and associated advertisement over the computer network to a receiving computer occurs in response to a request received from the receiving computer and streaming, in response to activation of the link included in the identifier, the video segment and associated advertisement to the receiving computer system (user selection of the pointer link transmitted in the email correspondence disclosed by "Streaming Email").

5. Claims 7-11 45, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild in view of "Streaming Email", Ellis et al. (6,774,926, of record), Sezan, and Kidder.

Regarding claim 7, Rothschild discloses a method of sending a video segment and an associated advertisement over a computer network (paragraph 48), comprising:

(a) acquiring a video segment at a computer system (the video portion of a video message, paragraph 48);

(b) selecting, by the sender, an advertisement stored at the server computer system by an advertiser (paragraphs 51-52); and

(c) transmitting from the sender computer to the server computer system an indication of the selected advertisement (paragraph 53).

Rothschild fails to disclose fails to disclose uploading a video segment and a still image in the form of a thumbnail from a sender computer system to the server computer system, assuring that the video segment is in a streaming format; and directing, using the sender computer, the server system to embed the video segment into a web page that is to be sent to by the server computer system to a receiving computer system when distributing the video segment with the selected advertisement.

In an analogous art, Ellis teaches uploading a video segment from a sender computer system to a server computer system (col. 3 line 55 – col. 4 line 4 and col. 7, lines 38-48), allowing smaller entities, such as home users, to create and provide video content (col. 3, lines 19-29).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include uploading a video segment from a sender computer system to the server computer system, as taught by Ellis, for the benefit of allowing smaller entities, such as home users, to create and controllably provide video content, such as personalized, or special interest, content.

Rothschild and Ellis fail to disclose a still image in the form of a thumbnail from a sender computer system to the server computer system, assuring that the video segment is in a streaming format; and directing, using the sender computer, the server system to embed the video segment into a web page that is to be sent to by the server computer system to a receiving computer system when distributing the video segment with the selected advertisement.

In an analogous art, "Streaming Email" teaches sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (pgs. 308-313, "Video Express Email"), providing the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include assuring the video segment is in a streaming format and sharing a pointer to the location where the video is accessible, as taught by "Streaming Email" for the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

Rothschild, Ellis, and "Streaming Email" fail to disclose acquiring a still image in the form of a thumbnail and the identifier created includes the still image and directing, using the sender computer, the server system to embed the video segment into a web page that is to be sent to by the server computer system to a

receiving computer system when distributing the video segment with the selected advertisement.

In an analogous art, Sezan teaches generating and associating thumbnail images with a video file in order to assist users in selecting video content for viewing (col. 4 line 40 - col. 5 line 2).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild, Ellis, and "Streaming Email" to include associating a thumbnail image with the video file, as taught by Sezan, for the benefit of assisting users in selecting video content for viewing, as a thumbnail image provides a user with a brief hint or indicator as to the content of the video, and assists a viewer in deciding whether to view the entire file.

Rothschild, Ellis, "Streaming Email, and Sezan fail to disclose directing, using the sender computer, the server system to embed the video segment into a web page that is to be sent to by the server computer system to a receiving computer system when distributing the video segment with the selected advertisement.

In an analogous art, Kidder discloses it was well known in the art at the time to embed video content into web pages for delivery of video content to viewers (fig. 3).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild, Ellis, "Streaming Email" and Sezan to include and embedding the video segment, identifier, and associated

Art Unit: 2421

advertisement into a web page, as taught by Kidder. The pointer to a network location taught by “Streaming Email” could just as well be a URL to a web address with the embedded video content and associated information, a well known means for distributing video content that includes the benefit of a unified interface for content delivery by a service provider who may wish to display additional advertising or user options via a web page layout.

Regarding claim 8, Rothschild, Ellis, “Streaming Email”, Sezan, and Kidder disclose the method of claim 7, wherein selecting an advertisement comprises using a criterion chosen by an operator of the sender computer system (Rothschild, paragraph 52).

Regarding claim 9, Rothschild, Ellis, “Streaming Email”, Sezan, and Kidder disclose the method of claim 8, wherein said criterion is a remuneration paid for selected said advertisement (Rothschild, paragraph 49).

Regarding claims 10 and 11, Rothschild, Ellis, “Streaming Email”, Sezan, and Kidder disclose the method of claim 8, wherein said criterion includes leaving said selection to the determination of said server computer system which selects the advertisement in a substantially randomized manner (Rothschild, paragraph 52).

Art Unit: 2421

Regarding claim 45, Rothschild, Ellis, "Streaming Email", Sezan, and Kidder disclose the method of claim 1, wherein acquiring a video segment and a still image in the form of a thumbnail from a sender at a computer system includes receiving the video segment through a Hypertext Transfer Protocol (HTTP) port (Rothschild, fig. 1, interactions take place through website 110).

Regarding claim 46, Rothschild, Ellis, "Streaming Email", Sezan, and Kidder disclose the method of claim 7, but fail to disclose assuring that the video segment is in a streaming video format includes analyzing a file representing the video segment to determine if the file is compatible with streaming video.

Examiner takes official notice that analyzing a file representing a video segment to determine if the file is compatible with streaming video in applications involving the distribution of streaming video files is notoriously well known in the art, as a verification step conserves system resources to prevent unnecessary transcoding.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method of Rothschild, Ellis, "Streaming Email", Sezan, and Kidder to include analyzing a file representing the video segment to determine if the file is compatible with streaming video.

Art Unit: 2421

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild, Ellis, "Streaming Email", Sezan, and Kidder as applied to claim 10 above, and further in view of Eldering et al. (6,820,277, of record) [Eldering].

Regarding claim 12, Rothschild, Ellis, "Streaming Email", Sezan, and Kidder disclose the method of claim 10, but fail to disclose said selection is based on a price paid by the advertiser.

In an analogous art, Eldering discloses providing advertisers the opportunity to bid upon advertisement opportunities, awarding the advertisement time slot to the highest bidder (col. 8 line 63 – col. 9 line 12).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild, Ellis, "Streaming Email", Sezan, and Kidder to select an advertisement based on a price paid by the advertiser, as taught by Eldering, for the benefit of allowing advertisers to bid upon advertisement opportunities, maximizing the advertising revenues generated by the server computer system.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOMINIC D. SALTARELLI whose telephone number is (571)272-7302. The examiner can normally be reached on Monday - Friday 9:00am - 6:00pm.

Art Unit: 2421

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DOMINIC D SALTARELLI/
Primary Examiner, Art Unit 2421